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PTO/SB/21 (09-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number 10/727,655

Filing Date December 5, 2003

First Named Inventor Szelenyi et al.

Art Unit 1614

Examiner Name Brian Kwong

Attorney Docket Number 6319-1814

**ENCLOSURES (Check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	1. Disclosure Citation List
<input checked="" type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	2. Copies of references
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	3. Return Receipt Postcard
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Thelen Reid Brown Raysman & Steiner LLP (Customer Number 29858)		
Signature			
Printed name	Jonathan M. Passer		
Date	February 23, 2007	Reg. No.	59,757

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Jonathan M. Passer	Date	February 23, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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The PTO did not receive the following listed item(s)

The PTO did not receive the following listed item(s) Fee Transmittal



Attorney Docket No.: 6319-1814

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Szelenyi et al. Examiner: Brian Kwong  
Serial No.: 10/727,655 Art Unit: 1614  
Filed: December 5, 2003  
Title: COMBINATIONS OF RETIGABINE AND SODIUM CHANNEL  
INHIBITORS OR SODIUM CHANNEL-INFLUENCING  
ACTIVE COMPOUNDS FOR TREATING PAINS

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

Sir:

In accordance with the duty of disclosure under 37 CFR §1.56 and pursuant to 37 CFR §§1.97-1.98, Applicant submits herewith an Information Disclosure Citation List, and a copy of each document listed therein.

The present Information Disclosure Statement is being filed after the mailing date of a first Office Action on the merits and thus a fee of \$180 is due pursuant to 37 C.F.R. §1.17(p). The Commissioner is hereby authorized to charge the fee, and to charge any deficiency or to credit any overpayment, to the undersigned attorney's Deposit Account No. 02-4270, with reference to attorney's docket No. 6319-1814. **A duplicate of this sheet is attached.**

The enclosed documents were either cited in the International Search Report ("the ISR") dated March 4, 2005 for a counterpart PCT application or is a U.S. patent document that is a counterpart to a non-English foreign patent document cited in the ISR. A copy of the ISR is enclosed.

Four of the foreign patent documents cited in the ISR are not in English. One of them, WO 01/22953, corresponds to U.S. Pat. 6,117, 900 to Rundfeldt et al. which is already of record. Of the remaining three, U.S. Patents 6,500,455 to Frantsits, 4,778,799 to Tibes et al., and

4,668,684 to Tibes et al, copies of which are enclosed, correspond to WO 00/59508, EP 189,788, and DE 3604575, respectively, and are submitted in lieu of translations.

L. Beck and M. Beck, *Der Gynaekologe*, 35:490-494 (2002) deals with the causes, diagnosis and treatment of "Kreuzschmerzen" (lumbago, lower back pain) in the practice of gynecology. The relevant portion is the paragraph entitled "Medikamente" on page 494, which translates as follows:

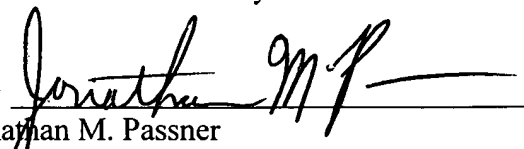
**Medication:** Initially, myotonolytics (muscle relaxants such as Predinol™ and Myoson™) as well as non-opioid analgesics are recommended for short term application. When inflammation is involved, the use of non-steroidal anti-inflammatory agents is indicated. Opioids should be limited to cases of chronic pain. With persistent pain, newer medicines such as flupirtine (Katadolon™) and tolperisone (Mydocalm™) are given.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicant reserves the right to dispute any of the listed documents as prior art during examination. Furthermore, Applicant does not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application. The submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made or that no other material information may exist.

The Examiner is requested to consider the enclosed documents, and indicate his or her consideration of the documents by initialing the enclosed Citation List adjacent the citation of each document and returning a copy of the initialed list to the undersigned.

Respectfully submitted,  
Thelen Reid Brown Raysman & Steiner LLP

Date: February 22, 2007

By:   
Jonathan M. Passner  
Reg. No. 59,757  
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Facsimile: (212) 895-2900



**Complete if Known**

*(Use as many sheets as necessary)*

Sheet	1	of	2
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Application Number	10/727,655
Filing Date	December 5, 2003
First Named Inventor	Szelenyi, Istvan
Art Unit	1614
Examiner Name	Brian Kwong
Attorney Docket Number	6319-1814

[illegible]

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> *Number <sup>4</sup> *Kind Code <sup>5</sup> (if known)	MM-DD-YYYY			
		EP 189,788 A1	08-06-1986	Tibes et al.		
		JP 2000-143510A(abstract)	05-23-2000	Eiichiro		✓
		WO 00/59487 A2	10-12-2000	Stoll		
		DE 3604575 A1	08-28-1986	Tibes et al.		
		WO 01/22953 A2	04-05-2001	Rundfeldt et al.		
		WO 01/01970 A2	01-11-2001	Burbridge et al.		

Date  
Considered

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

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Substitute for form 1449/PTO

## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

**(Use as many sheets as necessary)**

**Complete if Known**

Application Number	10/727,655
Filing Date	December 5, 2003
First Named Inventor	Szelenyi, Istvan
Art Unit	1614
Examiner Name	Brian Kwong
Attorney Docket Number	6319-1814

Sheet	2	of	2
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## U. S. PATENT DOCUMENTS

[illegible]

## FOREIGN PATENT DOCUMENTS

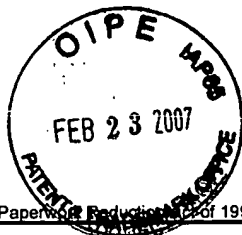
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)	MM-DD-YYYY			
		WO 00/59508 A1	10-12-2000	Frantsits		

Examiner Signature		Date Considered	
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)		<b>Complete if Known</b>	
		Application Number	10/727,655
		Filing Date	December 5, 2003
		First Named Inventor	Szelenyi, Istvan
		Art Unit	1614
		Examiner Name	Brian Kwong
Sheet 1	of 1	Attorney Docket Number	6319-1814

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		KUO et al., Inhibition of Na <sup>+</sup> Current by Diphenhydramine and Other Diphenyl Compounds..., Molecular Pharmacology, 2000, 57(1):135-143	
		BECK et al., Kreuzschmerzen in der Gynaekologischen Praxis, Gynaekologe, Springer Verlag, Berlin Germany, 2002, 35(5):490-494.	

Examiner Signature		Date Considered	
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